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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) YOR920010001US1																	
	Application Number	Filed																	
	09/817,475	March 26, 2001																	
	First Named Inventor																		
	T.V. Raman et al.																		
	Art Unit	Examiner																	
	2626	Michael P. Opsasnick																	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table><tr><td><input type="checkbox"/></td><td>applicant/inventor.</td><td></td><td>Signature</td></tr><tr><td><input type="checkbox"/></td><td>assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>William E. Lewis</td><td>Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/></td><td>attorney or agent of record. 39,274 Registration number _____</td><td>(516) 759-2946</td><td>Telephone number</td></tr><tr><td><input type="checkbox"/></td><td>attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td>October 25, 2006</td><td>Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p>				<input type="checkbox"/>	applicant/inventor.		Signature	<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	William E. Lewis	Typed or printed name	<input checked="" type="checkbox"/>	attorney or agent of record. 39,274 Registration number _____	(516) 759-2946	Telephone number	<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	October 25, 2006	Date
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☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): T.V. Raman et al.
Docket No.: YOR920010001US1
Serial No.: 09/817,475
Filing Date: March 26, 2001
Group: 2626
Examiner: Michael P. Opsasnick

Title: Systems and Methods for Marking and Later
Identifying Barcoded Items Using Speech

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the outstanding final Office Action dated July 25, 2006, please consider the following remarks:

REMARKS

The present application was filed on March 26, 2001 with claims 1-25. Claims 1-5, 7-9, 12-16, 20, 21 and 23-25 remain pending. Claims 1, 12, 21 and 25 are the independent claims.

In the outstanding final Office Action dated July 25, 2006, the Examiner rejects claims 1-5, 7-9, 12-16, 20, 21 and 23-25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,852,803 (hereinafter "Ashby") in view of U.S. Patent No. 6,453,281 (hereinafter "Walters") in further view of U.S. Patent No. 6,366,886 (hereinafter "Dragosh") and in still further view of U.S. Patent No. 5,758,322 (hereinafter "Rongley").

With regard to the rejection of claims 1-5, 7-9, 12-16, 20, 21 and 23-25 under 35 U.S.C. §103(a) as being unpatentable over the Ashby/Walters/Dragosh/Rongley combination, Applicants respectfully assert that the cited combination fails to establish a proper case of obviousness under 35 U.S.C. §103(a).

With regard to the §103(a) rejections, Applicants initially note that a proper case of obviousness requires that the cited references when combined must "teach or suggest all the claim limitations," and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

The collective teaching of Ashby, Walters, Dragosh and Rongley fails to suggest or render obvious one or more elements of independent claims 1, 12, 21 and 25 of the present invention. For at least this reason, a proper case of obviousness has not been established.

Current independent claim 1 recites a method of using speech for marking and subsequently identifying one or more items having electronically-readable identifiers respectively marked thereon. The method comprises the steps of: inputting at least a portion of the electronically-readable identifier marked on an item; inputting from a user a spoken utterance that corresponds to the item; converting the spoken utterance input by the user to text; associating the electronically-readable identifier input from the item with at least one of the spoken utterance input from the user and the corresponding text; and outputting the spoken utterance when the electronically-readable identifier associated with the spoken utterance is subsequently inputted; wherein the speech-to-text conversion

is performed on a computing device remotely located with respect to a computing system performing the other steps, and further wherein the computing device that performs the speech-to-text conversion archives electronically-readable identifiers and associated text-converted spoken utterances on a removable storage medium such that an archived mapping is created over time between items having electronically-readable identifiers and text-converted spoken utterances that are representative of user descriptions of the items wherein the archived mapping is specific to the user and is removably-portable and represents items that the user may interact with at a future time or place, and further wherein the spoken utterance input by the user is transmitted to the remotely-located computing device prior to speech-to-text conversion. Independent claims 12, 21 and 25 recite other aspects of the invention comprising similar limitations.

The Ashby/Walters/Dragosh/Rongley combination fails to teach or suggest one or more of the above limitations. No where does the combination disclose that the computing device that performs the speech-to-text conversion archives electronically-readable identifiers and associated text-converted spoken utterances on a removable storage medium such that an archived mapping is created over time between items having electronically-readable identifiers and text-converted spoken utterances that are representative of user descriptions of the items wherein the archived mapping is specific to the user and is removably-portable and represents items that the user may interact with at a future time or place, as in the claimed invention.

Rongley was introduced by the Examiner to disclose a removable storage medium, but no where does Rongley suggest of creating a user specific archived mapping between items having electronically-readable identifiers and text-converted spoken utterances that are representative of user descriptions of the items. Nor does Rongley disclose that the claimed archived mapping is removably portable and representative of items that the user may interact with at a future time or place.

Also, the Examiner has failed to identify proper motivation for combining Ashby, Walters, Dragosh and Rongley in the manner proposed. The Examiner provides the following statement of motivation beginning at page 6, first paragraph of the Office Action:

Therefore, it would have been obvious to one of ordinary skill in the art of remote speech signal processing systems to modify the combination of Ashby, III et al. (5,852,803) in view of Walters et al. (6,453,281) in further view of Dragosh et al (6366886) with remote accessible [sic] voice file user information as taught by Rongley (5758322) because it would advantageously reduce the possible errors of misrecognition (col. 11 lines 42-46).

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present §103(a) rejection of claim 1 of objective evidence of record that would motivate one skilled in the art to combine Ashby, Walter, Dragosh and Rongley to produce the particular limitations in question. The above-quoted statement of motivation provided by the Examiner appears to be a conclusory statement of the type ruled insufficient in the In re Sang-Su Lee case. Accordingly, the proposed combination appears to be based primarily on hindsight, with the Examiner attempting to reconstruct the claimed arrangement from disparate references.

Furthermore, Applicants respectfully assert that certain other rationale in the final Office Action offered by the Examiner is unsupportable and otherwise baseless. The Examiner states on page 3 that “Ashby et al's do not explicitly teach away from the converting user-spoken utterances to text,” and on page 5 that “neither Ashby et al. nor Walter et al explicitly teach against connection to a network,” and further on page 5 that “Ashby et al. also teach using a terminal workstation . . . which would suggest a network connection in the modern days (at least after 1996, while Ashby et al's patent has been filed in 1992, when network connectivity was not as prevalent).” Applicants contend that such statements are baseless and fail to provide the proper support for rejecting the subject limitations of the claims.

Independent claims 12, 21 and 25 include limitations similar to those of claim 1, and are therefore believed allowable for reasons similar to those described above with reference to claim 1.

Dependent claims 2-5, 7-9, 13-16, 20, 23 and 24 are believed allowable for at least the reasons identified above with regard to claim 1. One or more of these claims are also believed to define separately-patentable subject matter over the cited art.

In view of the above, Applicants believe that claims 1-5, 7-9, 12-16, 20, 21 and 23-25 are in condition for allowance, and respectfully request withdrawal of the various §103 rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis", written over the printed name and title.

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Date: October 25, 2006